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In The

Supreme Court of the United States

October Term, 1938

No. 222

The Washingtonian Publishing Company, Inc.,
Petitioner,

v.

Drew Pearson, Robert S. Allen and Van Rees Press, Inc.,
Respondents.

RESPONDENTS' BRIEF

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November 15, 1938.

EYNON PRINTING CO., INC., WASHINGTON, D. C.

Table of Contents

PAGE

I. THE FACTS 1

II. SUMMARY OF RESPONDENTS' CONTENTIONS 3

III. ARGUMENT:

Point 1. The copyright and the right to vindicate the ownership thereof by suit are separately created 4

Point 2. Petitioner, by its failure promptly to deposit copies and to secure registration of the December, 1931, issue of its magazine, became forever barred from maintaining an action for infringement of copyright thereof 10

Point 3. If the petitioner be not forever barred, by its failure promptly to deposit copies and secure registration of the work, from maintaining an action for infringement, it is at least barred from suing for any infringement occurring before it registered its claim and deposited its copies 15

Point 4. The decision herein is not in conflict with that rendered by any other court in the United States or England 19

IV. CONCLUSION 23

Authorities

PAGE

Cases:

Ashland Fire Brick Co. v. *General Refractories Co.*, 27 F. (2d) 744 17
Caliga v. *Inter-Ocean Newspaper Co.*, 215 U. S. 182..4, 16
Callaghan v. *Myers*, 128 U. S. 617 ..... 16*
Carter v. *Bailey*, 64 Me. 458 ..... 16*
Cate v. *Devon and Exeter Constitutional Newspaper Company*, L. R. 40 Ch. D. 500 22
Ebeling and Reuss, Inc. v. *Raff*, 28 USPQ 366 14
Freeman v. *The Trade Register, Inc.*, 173 Fed. 419 4
Goubaud v. *Wallace*, 36 Law Times (N.S.) 704 22
Haynes & Co. v. *Druggists' Circular*, 32 F. (2d) 215 19
Koppel v. *Downing*, 11 App. D. C. 93 ..... 13, 20
Krauth v. *Autographic Register Co.*, 285 Fed. 199 17
Lumière v. *Pathé Exchange*, 275 Fed. 428 ..... 19, 21
Mittenthal v. *Berlin*, 291 Fed. 714 22
New York Times Co. v. *Star Co.*, 195 Fed. 110 6
New York Times Co. v. *Sun Printing & Publishing Association*, 204 Fed. 586 4
People v. *Roberts*, 159 N. Y. 70 ..... 16*
Supreme Mfg. Corp. v. *Security Mfg. Co.*, 299 Fed. 65 17
United Thrift Plan, Inc. v. *National Thrift Plan, Inc.*, 34 F. (2d) 300 4
Wheaton v. *Peters*, 8 Pet. 591 ..... 4, 16*

Statutes:

Copyright Act of 1790 ..... 4*
Copyright Act of 1802 ..... 5*
Copyright Act of 1831 ..... 5*
"Copyright" Act of 1846 ..... 5*
Copyright Act of 1865 ..... 6*
Copyright Act of 1870 ..... 6*

* Refers to footnote.

PAGE

Copyright Act of 1891 ..... 7*
Copyright Act of 1909 4
Section 9 ..... 6*, 7, 9, 12
Section 10 8
Section 12 ..... 7, 8, 11, 12, 13, 14, 15, 16, 19
Section 13 ..... 12, 13, 15
Section 55 20
Section 59 8
Section 60 8
Section 61 18
Literary Copyright Act, 1842, 5 and 6 Victoria 21
Revised Statutes, 4916; 35 U. S. C. 64 17

Miscellaneous:

House Committee Report No. 2222, 60th Cong., 2d Sess. 11*

* Refers to footnote.

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THE WASHINGTONIAN PUBLISHING COMPANY, INC.,
Petitioner,

v.

DREW PEARSON, ROBERT S. ALLEN and VAN REES PRESS, INC.,
Respondents.

RESPONDENTS' BRIEF

I

THE FACTS

The undisputed and material facts appear in chronological order in the District Court's Findings of Fact (Record, pp. 27-28) but they are incorporated herein for the greater convenience of this Court.

In December, 1931, and for some time prior thereto, the petitioner was the owner and publisher at Washington, D. C., of a monthly magazine of general circulation called THE WASHINGTONIAN. On December 10, 1931, the pe-

titioner published an issue of THE WASHINGTONIAN and secured copyright thereof by means of the usual printed notice. However, *the claim to copyright was not thereupon registered and copies of the work were not thereupon deposited* in the Copyright Office. The said December issue contained, among other material, a featured article entitled "The Mills—of the Gods" written by one Rixie Smith under the pen name of Linthicum Hall. *The petitioner discontinued publication after this issue.*

On August 25, 1932, Liveright, Inc., one of the defendants below, published and offered for general sale a book entitled "More Merry-Go-Round" written by respondents Pearson and Allen and printed by respondent Van Rees Press, Inc. This book included a chapter entitled "The Wizards of Reconstruction" which contained matter practically identical with the said article by Rixie Smith in the December, 1931, issue of THE WASHINGTONIAN.

Copyright of the book "More Merry-Go-Round" was secured by means of the usual printed notice and, on August 26, 1932, Liveright, Inc., deposited two copies of the said book, together with the claim of copyright, in the Copyright Office, paid the fee, and obtained a certificate of registration. On December 14, 1932, the last edition of "More Merry-Go-Round" was printed.

On February 21, 1933, petitioner deposited copies of the December, 1931, issue of THE WASHINGTONIAN, together with claim of copyright, in the Copyright Office, paid the fee, and secured a certificate of registration. On the same day petitioner likewise deposited copies and obtained registration of the claims to copyright of the other eleven issues—January through November—of 1931.

On March 8, 1933, petitioner instituted this suit alleging infringement of the article appearing in the December, 1931, issue of THE WASHINGTONIAN.

Liveright, Inc., was adjudged bankrupt in June, 1933, and was not thereafter concerned with this proceeding. The trial occurred in February, 1935.

On March 28, 1935, the District Court, through Mr. Justice Letts, rendered an opinion (R. 23-26) finding the foregoing facts and holding that the bill should be dismissed because of the failure of The Washingtonian Publishing Company to comply with the provisions of the Copyright Act requiring prompt deposit of copies.

In February, 1936, Mr. Justice Letts granted a rehearing. During the latter part of October, 1936, he notified counsel for the parties that he would decide in favor of the petitioner but that there would be *no opinion*. Findings of Fact and Conclusions of Law (R. 27-29) and a Decree (R. 29-30) were filed in December, 1936.

An appeal was taken to the United States Court of Appeals for the District of Columbia and, in April, 1938, that Court reversed the District Court. A petition for a writ of certiorari was granted by the Supreme Court of the United States on October 10, 1938. (R. 45.)

II

SUMMARY OF RESPONDENTS' CONTENTIONS

The respondents do not contend that the petitioner did not secure a valid copyright of the December, 1931, issue of THE WASHINGTONIAN upon publication of the work with notice of copyright. However, they do contend that the conditions prescribed by the Copyright Act must be fulfilled in order to enable a copyright proprietor to support his ownership of the copyright by suit.

The respondents contend that, in order to vindicate its ownership of the copyright in question by suit, the petitioner must have first secured a right to sue by strictly fulfilling the requirements of the Act both as to prompt deposit, with the Register of Copyrights, of two copies of the work after publication and also as to securing registration thereof. (The petitioner denies that prompt deposit is necessary and alleges a right to maintain an action for infringement regardless of when the deposit of copies was made or the reg-

istration effected just so they occurred prior to the actual institution of the proceeding.)

The respondents further contend that, even though prompt deposit were held to be unnecessary, there is precluded any right of action for an infringement occurring *before* a late deposit of copies and registration of the work.

III

ARGUMENT

Point 1. The copyright and the right to vindicate the ownership thereof by suit are separately created.

When the Congress enacted the Copyright Act it did not sanction an existing right but created an entirely new one. *Caliga* v. *Inter-Ocean Newspaper Co.*, 215 U. S. 182, 54 L. ed. 150. The importance of strict compliance with the provisions of the Act has frequently been recognized. *Wheaton* v. *Peters*, 8 Pet. 591, 665, 8 L. ed. 1055, 1082; *Freeman* v. *The Trade Register, Inc.*, 173 Fed. 419, 421; *New York Times Co.* v. *Sun Printing & Publishing Association*, 204 Fed. 586, 587; *United Thrift Plan, Inc.*, v. *National Thrift Plan, Inc.*, 34 F. (2d) 300.

Prior to the enactment of the present Copyright Act (March 4, 1909, 35 Stat. L. 1075, 17 U. S. C. § 1) the copyright itself and also the right to maintain an action for infringement thereof were obtained *at the same time and, for the most part, in the same manner.*[1] When the conditions

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[1] (a) The Act of 1790, 1 Stat. 125, provided that no person should have the "benefit" thereof "unless he shall *before publication* deposit a printed copy of the title of such map, chart, book or books, in the clerk's office of the district court where the author or proprietor shall reside". Provision was also made for publication in a newspaper, within *two months*, of the clerk's record; also for delivery, within *six months*, of one copy of the work to the Secretary of State, but there was no penalty for failure in either of these re-

precedent to the creation of the copyright were fulfilled the right to maintain an action for the infringement thereof was *automatically created.*

The present Copyright Act introduced radical changes. It is no longer necessary to deposit anything to secure a copyright of a published work, but only to publish with the

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spects. The copyright was for a term of 14 years "from the recording the title thereof in the clerk's office".

(b) The Act of 1802, 2 Stat. 171, provided that, in addition to the requirements of the Act of 1790, a person seeking to obtain a copyright should, "before he shall be entitled to the benefit of the act" cause the clerk's record to be inserted "at full length in the title-page or in the page immediately following the title of every such book or books; and if a map or chart, shall cause the following words to be impressed on the face thereof, viz: '*Entered according to the act of Congress, the day of 18* (here insert the date when the same was deposited in the office) *by A. B. of the State of* (here insert the author's or proprietor's name and the State in which he resides).'" This is the first time that any notice was required to appear in the work for which copyright was being sought.

(c) The Act of 1831, 4 Stat. 437, continued to withhold the statutory benefits unless a copy of the title of the work was deposited in the district court clerk's office *before publication* and unless "information of copyright being secured" was given by *notice* appearing on the work as specifically prescribed. One copy of the completed work was required to be delivered to the clerk within *three months* after publication, and once every year the clerk was required to transmit to the Secretary of State a certified list of his copyright records, together with the copies of the works deposited in his office. There was no penalty for failure to deposit the copy of the completed work. The copyright term was extended to 28 years.

(d) The Act of August 10, 1846, 9 Stat. 106, to establish the Smithsonian Institution provided that every copyright proprietor should, *within three months* after publication, transmit one copy of his work "to the Librarian of the Smithsonian Institution, and one copy to the Librarian of

notice of copyright.[2] However, the ownership of a copyright does not create a right to maintain a suit for infringement. As stated in *New York Times Co.* v. *Star Co.*, 195 Fed. 110, 111: "Ownership of copyright and the vindication of such ownership by suit are *different things.*" This fact was recognized by the appellate court herein. (R. 41.)

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[2] Section 9 of the Copyright Act (35 Stat. 1077, 17 U. S. C. § 9) provides that "any person entitled thereto by this Act may secure copyright for his work by publication thereof with the notice of copyright required by this Act; and such notice shall be affixed to each copy thereof published or offered for sale in the United States by authority of the copyright proprietor, . . ."

Congress Library". This marked the advent of the Congressional Library into the copyright picture.

(e) The Act of 1865, 13 Stat. 540, required that a printed copy of every work "for which a copyright shall be secured" should be transmitted to the Library of Congress *within one month of the date of publication.* Failure to deposit had no effect upon the copyright or the right to sue, but such failure made it "the *duty of the Librarian of Congress to make demand* thereof in writing, at any time within *twelve months* after the publication thereof; and in default of the delivery thereof within *one month* after the demand shall have been made, the right of exclusive publication secured to such proprietor under the acts of Congress respecting copyright shall be forfeited." (Compare Section 13 of the Act of 1909, note 10 herein, post, p. 12.)

(f) The Act of 1870, 16 Stat. 213, provided that "no person shall be entitled to a copyright" unless, *before publication,* he deposited a copy of the title of the work addressed to the Librarian of Congress, and unless, ***within ten days after publication,*** he similarly deposited two copies of the work. However, copyright was initially "granted for the term of 28 years from the time of recording the title thereof". For the first time, this Act required the Librarian of Congress to keep an official record of every copyrighted work and information pertaining thereto. Also, for the first time, this Act provided that "no person shall maintain an action for infringement of his copyright unless he shall give

The things which must be done in order to create a right to maintain an action for infringement of copyright are set forth in Section 12 of the present Copyright Act (35 Stat. 1078, 17 U. S. C. § 12). Insofar as it is pertinent to this case that Section provides:

> "That after copyright has been secured by publication of the work with the notice of copyright as provided in Section 9 of this Act, there shall be ***promptly deposited*** in the Copyright Office or in the mail, addressed to the Register of Copyrights, Washington, District of Columbia, two complete copies of the best edition thereof then published, . . . to be accompanied in each case by a *claim of copyright.*[3] *No action or pro-*

[3] A "claim of copyright" is an application for registration under Section 10 (see note 4); it is not the notice of copyright. The application, in the case of a periodical, requires the full legal name and address of the copyright owner by whom the "copyright is claimed"; the title of the periodical; the place and date of publication; the name and location of the printer; and the date when the issue in question was first publicly distributed, as this marks the beginning of the copyright term. This information, together with the date of the receipt of the copies, and also other facts in the case of books, is entered upon the records of the Copyright Office and becomes a part of the *official public registry.*

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notice thereof" by inserting in each copy a statement that the work had been "Entered according to act of Congress, in the year , by A. B., in the office of the Librarian of Congress, at Washington." Therefore, under this Act, although copyright were secured upon deposit of title, it was nullified if copies were not deposited within ten days, and no suit could be maintained if the work were published without notice of copyright.

(g) The Act of 1891, 26 Stat. 1107, provided that there should be no copyright unless a copy of the title was deposited "*on or before the day of publication*", and unless two copies of the work itself were deposited "not later than the *day of publication*".

ceeding shall be maintained for infringement of copyright in any work until the provisions of this Act with respect to the deposit of copies and registration[4] *of such work shall have been complied with.*" (Emphasis supplied.)

Registration of claim to copyright, as provided by Section 10[5], includes the deposit of copies under Section 12, but is not mandatory except in connection with suit for infringement. Then it becomes just as essential as deposit. As a matter of fact, registration is of more lasting importance than deposit because Sections 59[6] and 60[7] of the Act

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[4] Section 10 (35 Stat. 1078, 17 U. S. C. § 10) provides that "such person *may obtain registration of his claim* to copyright by complying with the provisions of this Act, *including the deposit of copies*, and upon such compliance the register of copyrights shall issue to him the certificate provided for in section fifty-five of this Title." (Emphasis supplied.)

[5] See note 4.

[6] Section 59 (35 Stat. 1087, 17 U. S. C. § 59) provides:
"That of the articles deposited in the copyright office under the provisions of the copyright laws of the United States or of this Act, the Librarian of Congress shall determine what books and other articles shall be transferred to the permanent collections of the Library of Congress, including the law library, and what other books or articles shall be placed in the reserve collections of the Library of Congress for sale or exchange, or be transferred to other governmental libraries in the District of Columbia for use therein."

[7] Section 60 (35 Stat. 1087, 17 U. S. C. § 60) provides:
"That of any articles undisposed of as above provided, together with all titles and correspondence relating thereto, the Librarian of Congress and the register of copyrights jointly shall, at suitable intervals, determine what of these received during any period of years it is desirable or useful to preserve in the permanent files of the copyright office, and, after due notice as hereinafter provided, may within their discretion cause the remaining articles and other things to be destroyed:

authorize the disposition of copyrighted material even during the term of the copyright. However, the official entries of the Copyright Office continue as a perpetual registry and are obviously intended as such, petitioner's statement to the contrary (Supp. brief, p. 16) notwithstanding.

The fact remains that the very foundation of the right to maintain an action for infringement is deposit of copies and registration of the work. Neither of these has the slightest bearing upon the creation of the copyright itself under Section 9. That is obtained merely by publication with notice as required by the Act.

Inasmuch as no question is raised as to the copyright secured by petitioner it is only necessary to consider whether petitioner had any right of action at the time respondents utilized the material in question.[8]

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[8] Counsel for petitioner apparently seek to question the motives of the respondents when they state (Supp. brief, p. 12) that respondent Pearson "had worked with the petitioner through the November, 1931, issue of its publication, and was familiar with the article and publication and knew that the publishing of the article was made under notice of claim of copyright as prescribed by the Copyright Law (R. 5-7, 12-17)." But if counsel were to divulge the other facts appearing on the record pages cited and bearing upon the point it would appear that—

"*Provided*, That there shall be printed in the Catalogue of Copyright Entries from February to November, inclusive, a statement of the years of receipt of such articles and a notice to permit any author, copyright proprietor, or other lawful claimant to claim and remove before the expiration of the month of December of that year anything found which relates to any of his productions deposited or registered for copyright within the period of years stated, not reserved or disposed of as provided for in this Act;

"*And provided further*, That no manuscript of an unpublished work shall be destroyed during its term of copyright without specific notice to the copyright proprietor of record, permitting him to claim and remove it."

Point 2. Petitioner, by its failure promptly to deposit copies and to secure registration of the December, 1931, issue of its magazine, became forever barred from maintaining an action for infringement of copyright thereof.

We have already shown that the present Copyright Act is the first to separate the copyright from the right of action for infringement thereof, and that a right of action does not exist until deposit of copies and registration of the work. This Act is also the first to require that copies be deposited *promptly* instead of within a specific time limit.

Of course, the word "promptly" may refer to different periods of time, depending upon the circumstances, although in the present case not even the petitioner has suggested that a delay of 14 months could conceivably be so classified. However, there can be no question but that, if a particular deposit be held to be promptly made, *any* infringement of that work could be made the subject of an action by the copyright proprietor. This would be true even though the infringement took place in the interval between publication and the actual deposit of copies and the registration of the work.

" . . Pearson states that he had a perfect right to the full use of the said article; that by letter and check dated July 22, 1932, he purchased, and paid the said Rixie Smith for, the privilege of such use; . . . that the said Rixie Smith . . . released to The Washingtonian Publishing Company no rights whatsoever to copyright or otherwise appropriate to its exclusive use the said article in whole or in part, and that the said Smith claimed to have retained the rights to the said article; . . . that the company . . . was without funds to pay for the article or to pay the fee for securing registration of copyright; . . ." (R. 14.)

It is thus apparent that respondents acted in good faith when they purchased from the author and utilized the material in question.

Where it is admitted that the deposit was not made promptly, a strict application of the statute obviously requires that the copyright claimant be forever barred from maintaining an action for infringement of that particular copyright. If copies were not deposited promptly after publication the opportunity to comply with the requirement of promptness was gone forever as to that particular work.

The appellate court herein aptly stated (R. 41):

> "The reasons for promptness of deposit are present today in even greater measure than in earlier years. The liberalizing of the requirement should not be so construed as to defeat its purpose.[9] Appellee's [petitioner's] failure to comply with the Act in the present case, coupled with discontinuance of publication of its magazine and apparent abandonment of its copyright, produced just such a result as Section 12 was designed to prevent."

Petitioner contends (Supp. brief, p. 4) that the omission of the word "promptly" in the last part of Section 12 relating to the maintenance of an action for infringement is evidence that it does not apply. This overlooks the fact that Section 12 withholds any right of action "until the provisions of this act *with respect to the deposit of copies* and

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[9] House Committee Report No. 2222, 60th Cong., 2d Sess., on the bill which became the Copyright Act of 1909 shows an intention to remedy the hardship of the then existing law providing that no person should be entitled to a copyright unless two copies of the work were deposited not later than the day of publication. The Report called attention to the fact that many copyrights had been lost because, through accident or mistake, the deposit requirement had not been met. Therefore, the Report favored the proposed bill requiring that two copies of any work should be "promptly" deposited. Petitioner lays great stress upon this Report. (Supp. brief, pp. 4-5.)

registration of such work shall have been complied with." The only deposit previously mentioned relative to copyright under Section 9 is the *prompt* deposit specified in the first part of Section 12. Obviously, then, the provision as to prompt deposit must be the one to which reference is made.

Petitioner also contends that the decision of the appellate court herein "renders the penalty of voidance of copyright provided by Section 13 [10] but a hollow threat" because "By the time the penalty becomes applicable it is no longer possible to promptly deposit copies" and, "As an unenforceable copyright is obviously worthless, the voidance thereof would be an idle gesture." This contention is based upon an entirely erroneous impression as to the purpose not only of Section 13 but also of the organic change wrought in the copyright law by the Act of 1909.

Section 13 provides that, if copies be not promptly deposited as required by Section 12, a fine may be imposed and the copyright shall become void. But this is contingent upon the failure of the copyright claimant to meet the demand of the Register of Copyrights for the deposit of copies—a demand which the Register is *not required,* but *only authorized,* to make. The Register has no means of

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[10] Section 13 (35 Stat. 1078, 17 U. S. C. § 13) provides: "That should the copies called for by section twelve of this Act not be promptly deposited as herein provided, the register of copyrights may at any time after the publication of the work, upon actual notice, require the proprietor of the copyright to deposit them, and after the said demand shall have been made, in default of the deposit of copies of the work within three months from any part of the United States, except an outlying territorial possession of the United States, or within six months from any outlying territorial possession of the United States, or from any foreign country, the proprietor of the copyright shall be liable to a fine of one hundred dollars and to pay to the Library of Congress twice the amount of the retail price of the best edition of the work, and the copyright shall become void."

knowing when copies should be deposited because, unless he is advised by an interested party or learns by his own observation, he does not know when a notice of copyright has been published. After he finds that there has been a failure on the part of the copyright claimant to deposit copies, the latter is subject to no *mandatory* penalty under Section 13 but only to a demand which the Register *may* make upon him to furnish copies. Of course, if he fail to heed the demand, he subjects himself to the possibility of a fine and to having his copyright become void.

As a practical matter, Section 13 is primarily intended to influence copyright claimants outside the country—persons who might be more inclined to deposit the required copies upon threat of the loss of the copyright than upon threat of a fine. Actually, as aforesaid, the probability, or even possibility, of a proceeding under Section 13 is more fiction than fact because of the liklihood that the Register will never know of the notice of copyright. Section 12 holds the real key to the situation, as seen in the instant case. Deposit was here made 14 months late, and then not as a result of a demand but because the petitioner wanted to bring suit. It is quite evident that otherwise copies would not have been deposited to this day.

It is significant that Section 13 is primarily designed to enrich the Library of Congress. Even the fine suggested is to be accompanied by the payment of "twice the amount of the retail price of the best edition of the work." *Registration is not mentioned.* The Library of Congress is not interested in the registration of a claim to copyright, but only in copies of the work covered by the claim. Authors, publishers, and the general public, on the other hand, are definitely interested in registration. As stated in *Koppel* v. *Downing,* 11 App. D. C. 93, 104:

> ". . . The law of copyright, while securing a long continued monopoly, contemplates, and the *policy of*

> *it requires* that the *public should have notice,* by a true and correct *official registry,* as to the real author or proprietor entitled to the enjoyment of such monopoly as against the public. . . ." (Emphasis supplied.)

Only by means of such an official registry is it possible to learn authoritatively the identity of the copyright claimant, and so be in a position to ascertain the extent of the copyright, that is, whether it is exclusive, or whether certain rights, such as second serial rights, are reserved to the author. In the latter case, it would be important to ascertain the true name of the author, especially if a pen name were used, as here.

In this case petitioner made no effort promptly to deposit copies of the December, 1931, issue of its magazine or to obtain registration of its claim to copyright thereof but waited until 14 months after publication. At the same time it also deposited copies and obtained registration of its claim to copyright of all the other 11 monthly issues which had appeared in 1931. (R. 28.) The obvious reason for depositing copies when it did, on February 21, 1933, was to try to acquire the right to maintain this action which it filed on March 8, 1933. (R. 1, 28.) In fact, petitioner ceased publication of its magazine after the December, 1931, issue. (R. 28.)

Counsel have been able to find only one case wherein the requirement of prompt deposit in Section 12 was before a court. That is the case of *Ebeling and Reuss, Inc.* v. *Raff, Collector, and Wright, Tyndale & Van Roden, Inc.,* 28 U. S. P. Q. 366, decided by the District Court for the Eastern District of Pennsylvania and cited by the appellate court herein. (R. 42.) The Pennsylvania court stated (p. 368):

> ". . . We merely hold that the neglect to observe the statutory requirements referred to, 'promptly', (such is the peremptory word of Section 12), was fatal

> to the right of Wright, Tyndale & Van Roden, Inc., to inaugurate the 'action or proceeding' . . ."

This quotation is significant, not alone because of the holding that failure to deposit promptly is *fatal*, but also because Section 12 is specifically mentioned. Counsel for petitioner insist that the Pennsylvania court was in no way concerned with prompt deposit of copies. They also insist that the appellate court herein "in no way referred to the case". (Supp. Brief, p. 8.)

The petitioner, by failing promptly to deposit copies of its December, 1931, issue, was precluded from maintaining this, or any other, action for infringement of copyright covering material contained therein.

Point 3. If the petitioner be not forever barred, by its failure promptly to deposit copies and secure registration of the work, from maintaining an action for infringement, it is at least barred from suing for any infringement occurring before it registered its claim and deposited its copies.

The petitioner contends that the requirement of Section 12 that copies be deposited promptly has nothing whatsoever to do with the maintenance of an action for infringement but only with the demand which the Register of Copyrights is authorized to make under Section 13. Even though this were true the petitioner cannot prevail because the act of infringement in question occurred long before any effort was made to deposit copies and obtain registration. As stated by the appellate court herein (R. 42):

> ". . . the purpose of the law was clearly not to give retroactive effect to a grossly tardy compliance and thus to establish *ab initio* appellee's [petitioner's] right to maintain an action against one who in the interim had acted adversely to its interest. . . ."

Analogies are frequently drawn between copyrights and patents.[11] In the present case the position of the respondents, under the most generous construction of Section 12, is closely analogous to that of a person to whom is available the defense of intervening rights in a suit involving the infringement of a reissue patent. Petitioner erroneously states (Supp. brief, p. 17) that in the case of *Caliga* v. *Inter-Ocean Newspaper Company,* 215 U. S. 182, "it is held (p. 189) that reissue of patents is not applicable to copyright." The proceeding was for the infringement of a copyright of a painting. The copyright proprietor had attempted to take out a new copyright for the same painting after making slight changes in the title and description. The Court stated that "under the patent law it has been held that there is no authority for double patenting" and "We think the same principle, in this aspect, controls [here], as in the case of a patent. The plaintiff had already exhausted his statutory right and the second attempt availed him nothing." It is thus seen that the case has nothing whatsoever to do with *reissue* patents. However, it does add to the analogies already cited between copyrights and patents.

Whenever a patent is wholly or partially inoperative or invalid by reason of a defective or insufficient specification, or by reason of the patentee claiming as his invention more

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[11] As between themselves, the respective rights of co-owners of copyrights have been held to be analogous to those of co-owners of patent rights. *Carter* v. *Bailey,* 64 Me. 458, 18 Am. Rep. 273. Analogies between patent infringements and copyright infringements have also been drawn by some courts in arriving at the proper amount of damages. *Callaghan* v. *Myers,* 128 U. S. 617, 32 L. ed. 547. Analogies have likewise been drawn between patents and copyrights in regard to the question of taxation. *People* v. *Roberts,* 159 N. Y. 70, 53 N. E. 685. It has also been held that the loss of authorship by publication is analogous to the loss of rights of invention by the sale of a machine which might have been patented. *Wheaton* v. *Peters,* 8 Pet. 591, 8 L. ed. 1055.

than he had a right to claim as new, and if the error arose by inadvertence, accident, or mistake, and without fraudulent intent, the issued patent may be surrendered and a new patent for the same invention, in correct form, be reissued to the patentee. R. S. § 4916, 35 U. S. C. § 64. Under such circumstances, the courts have held that a person who, between the date of the original issue and the date of an application for a reissue, makes or sells an article or uses a process which is broader than the original grant but is included in the application for reissue, acquires an intervening right as against the patentee. *Ashland Fire Brick Co.* v. *General Refractories Co.* (6th Cir.), 27 F. (2d) 744, 746, cert. dismissed, 278 U. S. 662; *Krauth* v. *Autographic Register Co.* (D. C. N. J.), 285 Fed. 199, reversed on other grounds, 3rd Cir., 286 Fed. 470; *Supreme Mfg. Corp.* v. *Security Mfg. Co.* (9th Cir.), 299 Fed. 65, cert. denied, 266 U. S. 614. (Opinion of appellate court herein, R. 42.)

As in the case of a reissue patent, so here, the required initial step was taken. The inventor makes application for a patent; the proprietor publishes notice of copyright. Intervening rights may arise in the one case because the inventor fails to place his specifications and/or claims in proper form to give him the protection to which his invention entitles him, and, in the other case, because the proprietor fails to comply with the requirements of the Copyright Act in order to qualify to maintain a suit for infringement. Until the proprietor complies, he can no more successfully sue than can the inventor successfully sue for an infringement based upon specifications and/or claims which *might* properly have been made, but which were omitted and, therefore, required a reissue patent to cover them. Until the required statutory steps are taken, neither the inventor nor the proprietor may challenge the assumption to which his failure gives rise, namely, that potential rights were abandoned and the matter dedicated to the public, and, until this assumption is rebutted, any acts which might have been actionable if the required statutory

steps had been taken give to the performers thereof intervening rights in the form of a license which can only be terminated by the filing of an adequate application for a reissue patent by the inventor, and the deposit of copies and application for registration of claim of copyright by the proprietor.

In the present case the first alleged infringing act was the publication of certain material eight months *after* petitioner's publication of notice of copyright, and six months *before* registration and the deposit of copies, while the last alleged infringing act occurred two months before registration and deposit by petitioner. Publication by respondents of the said material *after* petitioner's deposit of copies and registration of claim of copyright might be said to constitute an actionable infringement, if such publication had occurred, but petitioner is clearly estopped to deny the right of respondents to their said publication during the period of the petitioner's failure properly to protect itself by registration and deposit of copies as required by the Act.

There is also a practical reason for this construction that becomes obvious from a consideration of the contrary interpretation which, apparently, the petitioner urges, namely, that a copyright claimant may sue for infringement occurring any time after publication, and within the 28-year copyright period, provided copies are deposited and registration completed before suit is instituted. Under such a construction a publisher of a daily newspaper could include a copyright notice in each issue of his paper but decide that, instead of depositing copies and paying the two-dollar registration fee,[12] all of which would exceed $700 per year, he

[12] Section 61 of the Copyright Act (45 Stat. 714, 17 U. S. C. § 61) provides "That the register of copyrights shall receive, and the persons to whom the services designated are rendered shall pay, the following fees: For the registration of any work subject to copyright, deposited under the provisions of this Act, $2, which sum is to include a certificate of registration under seal: . . ."

would merely wait and see if any financially responsible party utilized material contained in any one of the issues and, if so, he would proceed to deposit copies of the issue in question, register his claim, and then institute proceedings, even though the issue in question had appeared 25 years previously and the newspaper had been out of existence more than 20 years. He would only be required to bring suit within a reasonable time so as to avoid the defense of laches. *D. O. Haynes & Co.* v. *Druggists' Circular,* 32 F. (2d) 215. Surely, no court would countenance a proceeding under such circumstances, but under this construction of the statute it would be perfectly proper. There is no middle ground.

The present Copyright Act, unlike its predecessors, specifies no period within which deposit and registration must occur, but merely requires that copies be deposited *promptly.* But under petitioner's theory it makes no difference whether they are deposited one year or 27 years later, as long as they are deposited, and registration obtained, before suit is filed. The word "promptly" in Section 12 is not only meaningless but, in practice, according to petitioner, there is added a clause stating that deposit and registration do not create but merely perfect the right to sue. Needless to say, this may not be done.

It is, therefore, submitted that even the most charitable construction of Section 12 withholds the protection afforded by the remedial provisions of the Act until copies are deposited, unless they are promptly deposited after publication, and precludes suit for alleged infringements occurring during any unnecessary delay of the copyright claimant in complying with the provisions of the Act requiring registration and prompt deposit of copies.

Point 4. The decision herein is not in conflict with that rendered by any other court in the United States or England.

Counsel for petitioner rely upon the case of *Lumière* v. *Pathé Exchange,* 275 Fed. 428. However, the facts make it

wholly inapplicable, and the only reference to prompt deposit is based upon *obiter dictum*. The only question involved is that of a proper *registration* of copyright, the registration which was first secured having been inadequate for the purpose intended.

The copyright in question was that of a photograph. Under the law it was necessary promptly to deposit one copy if the article were not to be reproduced for sale and two copies if it were. Inasmuch as sale was contemplated, two copies of the photograph were promptly deposited as required by Section 12. However, the application for registration, which was essential to the creation of the right to maintain an action for infringement in any case, apparently did not give the date of publication as required in cases where sale is contemplated. Therefore, the date was omitted in the certificate of registration, which was authorized by Section 55 (37 Stat. 724, 17 U. S. C. § 55) and which "shall be admitted in any court as prima facie evidence of the facts stated therein." Accordingly, the registration was only good for photographs not to be reproduced for sale. The District Court dismissed the bill without prejudice to the right of the plaintiff to institute another action after he had secured a proper certificate of registration. Both parties appealed, each contending that a decree should have been entered on the merits in his favor. The Circuit Court of Appeals for the Second Circuit affirmed the action of the District Court.

There was *no question concerning the deposit of copies*, promptly or otherwise. There had been full compliance with the statute in this regard. In fact there had also been registration of the copyright, all necessary information having been given with the exception of the date of publication. The fundamental requirement of the law, as expressed in *Koppel* v. *Downing*, supra, had thus been met. The only question involved was the *incompleteness of the registration*—the omission of the date of publication.

The appellate court considered the *Lumière* case and concluded (R. 41-42) that it—

> ". . . did not decide the question of the present case. The Court in that case expressly avoided consideration of 'Other important and difficult questions depending upon the construction of the Copyright Act . . .' And in his concurring opinion, Hough, J., said:
>
> > 'I agree with the foregoing opinion *as far as it goes*. There are, however, two points for which this decision will by inference be thought authority and as to which I do not wish to be concluded. They are: (1) . . . and (2) whether in any form of action plaintiff can recover damages for infringements committed *before he* not only registered his claim of copyright but *deposited the requisite number of copies.*' (Italics supplied.)
>
> "Judge Hough's second reserved point is the one with which we are concerned."

Counsel for petitioner also rely upon the construction which the English Courts place "upon the corresponding provisions of the English Copyright Law", and they quote Section 24 of the *Literary Copyright Act*, 1842, 5 and 6 Victoria, c. 45. (Supp. Brief, p. 9.) That Act provided only a means whereby the proprietor of a copyright could make entry in a registry book of the title of the copyrighted work, the date of publication, the name and residence of the publisher, and the name and residence of the proprietor. *There was no requirement as to the deposit of copies, promptly or otherwise.* Section 24 provided that no proprietor of a copyright could maintain a suit for infringement—

> ". . . *unless* he shall before commencing such action, suit or proceeding, have caused an entry to be made in the book of registry of the Stationers' Company, of

such book pursuant to this act: Provided always, that the omission to make such entry, shall not *affect* the copyright in any book, but *only the right to sue* or proceed in respect of the infringement thereof as aforesaid; . . ." (Emphasis supplied.)

This provision was discussed in the opinion of Mellor, J., in the case of *Goubaud* v. *Wallace*, 36 Law Times (New Series, 1877) 704, 705, 25 W. R. 604, cited by petitioner, wherein the following statement appears:

". . . the registration of copyright is merely a condition precedent to the bringing an action for infringement, and not to the existence of the copyright itself. Registration, in fact, is necessary only to *perfect the right to sue, not to create it.*" (Emphasis supplied.)

It is thus seen that registration does not create the right to sue but is merely a condition precedent to the exercise of that right.

That registration may, and usually does, take place *at any time prior to the commencement of suit* under the English act is definitely stated by Lord North in *Cate* v. *Devon and Exeter Constitutional Newspaper Company* (1889), L. R. 40 Ch. D. 500, 506, 37 W. R. 487, also cited by petitioner:

". . . It is well known that registration is only necessary as a condition precedent to suing; and the almost universal practice on the part of large publishers notoriously is that they do not register until just on the eve of taking some proceeding; then they take care to register their copyright, and sue upon it. . . ."

This statement of Lord North is in marked contrast with the observation of the New York District Court in *Mittenthal* v. *Berlin*, 291 Fed. 714, also cited by petitioner:

". . . What usually happens is that when a work is printed the publisher wishes to get it to the public as soon as possible. *He may safely do so, if he sees to it*

that two copies go along to Washington with reasonable dispatch . . ." (Emphasis supplied.)

The question involved was whether a deposit *before* publication, instead of promptly thereafter, was a sufficient compliance to support a suit for infringement. The court held that it was and, as seen in the foregoing quotation, it recognized that the deposit of copies "with reasonable dispatch" is essential to establish the right to protect the copyright.

IV

CONCLUSION

The Copyright Act of 1909 simplifies the procedure for securing a copyright of a published work, but divorces therefrom the procedure whereby the right to maintain an action thereon is obtained. The petitioner secured a copyright but failed to take the necessary statutory steps to place itself in a position to vindicate its ownership of that copyright by suit against respondents or anyone else acting in a manner allegedly adverse to its interests within a period of fourteen months after publication.

The appellate court properly held that the purpose of the law is not to give retroactive effect to grossly tardy compliance with its provisions. Therefore, the judgment reversing the District Court should be affirmed.

Respectfully submitted,

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November 15, 1938.